Attorney Docket No. 39700-580001US/NC39543US
Customer No. 64046

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Confirmation No.: 7976

Bajko GABOR, *et al.* Art Unit: 2436

Application No.: 10/615,419 Examiner: Daniel L. HOANG

Filed: July 9, 2003

For: METHOD FOR SETTING UP A SECURITY ASSOCIATION

Mail Stop Pre-Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This Pre-Appeal Brief Request for Review is with regards to the Final Office action mailed September 29, 2010. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. Reconsideration and Allowance is respectfully requested in view of the Remarks contained in the following pages.

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REMARKS

Status of Claims

Claims 1, 2, 5-8, 12, 26, 29, 31, 33, 35, 37-29, and 42-57 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2003/0154400 to Pirttimaa et al. ("Pirttimaa") in view of U.S. Patent No. 7,159,109 to Egevang.[1]

A. Egevang merely discloses a network address translator including a list of identifiers each of which represents a tunnel terminating at a device

The Examiner takes an unreasonable and improper position with respect to Egevang. Instead of what the Examiner alleges at page 4 of the Final Office Action mailed September 29, Egevang discloses a mechanism for managing secure connections that allegedly improves the performance of packet switching networks by improving the management of a "Security Association," which in Egevang's disclosure is the same as a "secure connection." Egevang at column 2, lines 5-8. Egevang also states that address translation for secure connections may include translating many addresses into a few or a single address, and vice versa. Egevang at column 2, lines 20-30.

But such translating does not disclose creating, based on a prefix, a security association between a user equipment and call state control function, such that the security association remains valid for the user equipment and the call state control function over a plurality of internet protocol addresses having that prefix. It thus follows that Egevang fails to disclose or suggest the following features of claim 1: "forwarding, by a user equipment, a prefix value to a node in a packet switched environment to create a security association with the node based on the prefix value, said prefix value referring to a portion of a first internet protocol address, wherein the node comprises a call state control function, wherein the security association is valid between the user equipment and the node for a plurality of different internet protocol addresses, each of said plurality of internet protocol addresses comprising said portion of the first internet protocol address to which the prefix value refers, wherein the user equipment comprises at least one processor."

[1] Although the Examiner listed claim 29 on page 3 of the Final Office Action, Applicants will assume in order to expedite prosecution that the Examiner meant claim 28 as claim 29 was previously canceled.

Moreover, Egevang clearly states that the network address translator, such as network node 106, is **NOT** part of the security association or secure connection. Egevang at column 4, lines 26-31. **The Examiner's positions with respect to Egevang clearly contradict Egevang's teachings.** Specifically, the Examiner states:

> *For this limitation, examiner relies on the Egevang reference. Egevang teaches a method for managing address translation for secure connections. See col. 8, lines 22-67 and col. 9, lines 1-29, wherein Egevang teaches first setting up a security association for communication between network node 102 and Router 106. Network nodes 110 and 112 communicate with router 106 with their own internal addresses in order to send packets to node 102. Router 106 sets up a security association to communicate with node 102. When nodes 110 or 112 communicate with router 106, router 106 translates their internal addresses into a common external address using address translation in order to communicate packets to node 102. The security association is set up for both inbound and outbound traffic. Once the security association is set up for router 106, both nodes 110 and 112 may use the same security association without the need to set up separate security associations. Examiner views this to be analogous to the limitation claimed by applicant above. It is clear that the security association is valid for multiple IP addresses. It would have been obvious to one of ordinary skill in the art to modify the invention taught by Pirttimaa to include setting up a security association that is valid for multiple IP addresses, as taught by Egevang, in order to improve management of a Security Association by improving the overall capacity and performance of the network (Egevang, col. 2, lines 3-30).*

Final Office Action at page 4.

But the Examiner's above-noted positions contradict Egevang's teaching that network node 106, is **NOT** part of the security association. For example, the Examiner states that "Router 106" sets up a security association to communicate with node 102," (see Final Office Action at page 4) but that cannot be the case since Egevang explicitly states that the router is **NOT** part of the security association. Egevang at col. 4, lines 26-31. A fair reading of Egevang at col. 7, line 55 through col. 9, line 15 reveals that contrary to the Examiner's statements at page 4 of the Final Office Action, the only creating being performed by Egevang (or router 106) is the creation of a list of identifiers, each representing a tunnel (see, e.g., step 602 of Egevang).

B. The Examiner improperly ignores the express language of claim 1

The Examiner alleges that "It is clear that the security association is valid for multiple IP addresses." But the Examiner's statement shows that the Examiner has also ignored the express language of claim 1 reciting "wherein the security association is valid between the user equipment and the node for a plurality of different internet protocol addresses." Indeed, the security association and the plurality addresses are for **the** user equipment and **the** node (which is claimed as a "call state control function"). The Examiner's position is thus ***unreasonable*** given the noted language of claim 1."[2]

C. Pirttimaa does not constitute prior art under 35 U.S.C. §103(c)

Pirttimaa does not qualify as prior art under 35 U.S.C. § 103(a) because the instant application and **Pirttimaa** are owned by the same entity, i.e., Nokia Corporation.[3] Specifically, 35 U.S.C. § 103(c) states:

> (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Therefore, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

In view of A -C above, claim 1 is allowable over Pirttimaa and Egevang, whether these references are taken individually or in combination, and the rejection of claim 1 under 35 U.S.C. §103(a), as well as claims 2, 3, 5-8, 12, and 33, at least by reason of their dependency should be withdrawn.

Independent claims 26, 31, and 38, although of different scope, include one or more features similar to those noted above with respect to claim 1. For at least the reasons given above, claims 26, 31, and 38 as well as dependent claims 35, 39, and 42-57 at least by reason of their dependency, are allowable over Pirttimaa and Egevang, whether taken alone or in combination, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

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[2] *See In re Suitco Surface, Inc.* (Fed. Cir. 2010) (finding that although the PTO is entitled to take the broadest reasonable construction of a claim term, the PTO's construction cannot be unreasonable in view of the claim language and the specification).

[3] **Pirttimaa** was published as patent application on August 14, 2003, which is well after the filing date of the instant application. Thus, it only qualifies as prior art under 35 U.S.C. §102(e), making **Pirttimaa** ineligible as prior art under 35 U.S.C. §103(a).

Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due. however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-580001US/NC39543US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

Date: 17 December 2010

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